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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,229	07/22/2003	Manuel Marquez-Sanchez	67079	6970
48940	7590	02/16/2006	EXAMINER	
FITCH EVEN TABIN & FLANNERY 120 S. LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			DRODGE, JOSEPH W	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,229

Applicant(s)

MARQUEZ-SANCHEZ ET AL.

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 Decembert 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1-27 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the independent claims 1,10,13 and 19, scope of the terminology “more effective for removing the solute from a fluid...relative to an inorganic gel coating that has not been molecularly imprinted...where both filtrations are performed under similar conditions” remains unclear, since neither types of solute or types of fluid have been recited, neither has any of the filtering parameters such as concentration , types and size of solutes or contaminants being filtered, flow rates, pressure, pressure drops, temperature, filter pore size, etc. In particular, scope of added terminology “similar conditions” merely causes additional confusion, there being no guidance for scope of “similar” or meaning of “conditions”.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5-7,9 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Doktycz et al PGPUBS document US2004/0173506 published 09/09/2004.

Doktycz et al disclose an adsorbent (paragraph 46) polymeric filter material comprising fibrous support material with amino groups [as in claim 3] (paragraphs 14,50,97 and

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98), adsorbent gel coating adhered thereto, such as silica or silane/gel or hydrogel [as in claims 5-7], (paragraphs 64,65, 96 and 97). The fibers are also molecularly specialized, i.e. imprinted for the sorption, removal and/or sensing of specific biological substances on a molecular scale (paragraphs 6,7,18,19,48,100 and 101).

For method claim 19, see paragraph 18 concerning filtration of various medical, and biomedical solutes from cellular fluids.

Claim language pertaining to method of forming the gel coating on the fibrous support material by templating has been given little patentable weight, since no corresponding structure or method steps are present in the instant claims, the methods of imparting adhering a gel coating material to a fibrous support material having charged groups is deemed to be equivalent.

Claim 2 merely alludes to a solute removal process, so does not define further apparatus structure.

For claim 9, the filter is described without an accompanying housing or enclosure, and as forming a "self-assembly" hence inherently self-supporting, in paragraph 4.

ALLOWABLE SUBJECT MATTER

Claims 10-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Independent claims 10 and 13 distinguish over the closest prior art, encompassing

Doktycz et al and the Vu et al publication "A facile method to deposit zeolites Y and L

onto cellulose fibers” in view of the recited method step of “molecularly imprinting the solute on the inorganic gel coating with the template molecules present during formation of the inorganic gel coating”. Although Doktycz et al teach formation of molecular imprinting of molecular fibers and a gel coating, imprinting with template molecules is not envisioned. Vu et al and other publications teach formation of a coated fibrous filter by depositing gel or semi-solid material onto a fibrous substrate by processes including heating, pressurizing, and chemical bonding, not however suggesting “molecular imprinting with a template technique.

Claims 4,8 and 21-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 4 would distinguish in view of recitation of the fibrous support material comprising cellulose. It is deemed not apparent to combine the cellulose fiber filter of Wei with Doktycz et al, since Wei does not suggest a fibrous filter with fiber having coating that has been molecularly imprinted.

Each of claims 8,21 and 22 would distinguish in view of recitation of molecularly imprinting the membrane gel coating for caffeine or purifying a fluid comprising caffeine.

Each of claims 22,24 and 27 would distinguish in view of recitation of treating a fluid comprising a lipid-containing material.

Claim 25 would distinguish in view of recitation of the treated solute comprising a pesticide or herbicide.

Claim 26 would distinguish in view of treating a fluid comprising a natural food matrix.

Applicant's arguments filed on December 29, 2005 have been fully considered but they are not persuasive.

It is argued that the the apparatus and method of use claims distinguish over Doktycz in view of the limitation of the coatings being molecularly imprinted for the solute using template molecules. It is submitted that Doktycz teaches a product that appears to be the same as that of applicant's and produced by a similar process (molecularly specializing fibers and coating characteristics on a molecular scale, especially at paragraphs 6,7,18,19,48,100 and 101 of the reference).

When the reference teaches a product, or a method of its use, that appears to be the same as that claimed, although produced by a distinguishably different process, the burden is on applicant to establish that their product is patentably distinct (See in re Marosi 710 F. 2d 799, 218 USPQ 289 (Fed Cir. 1983) and In re Thorpe 777 F. 2d 695, 227 USPQ 964).

The arguments concerning such patentable distinction are not commensurate with the scope of the disputed claims, It is specifically argued that the imprinted gel claimed can distinguish between targeted solute and close chemical analogs with excellent selectivity. However, it is submitted that the instant claims merely are drawn to effectiveness of removing solutes, generally, from the fluid being treated, and not to selectively removing specific solutes, without removing other or closely related solutes.

The claims are completely silent as to selective removal of solutes or substances from a fluid being treated.

Furthermore, no experimental data or verifying documentation has been presented drawn to comparison of an adsorbent filter material having a molecularly imprinted gel coating to an adsorbent filter material where the coating is treated or applied in other manners. Doktcyz does selectively remove molecules from a fluid with the adsorbent filter using size, charge and other parameters of fibers and coatings, that are specifically nanoengineered for particular types of molecules.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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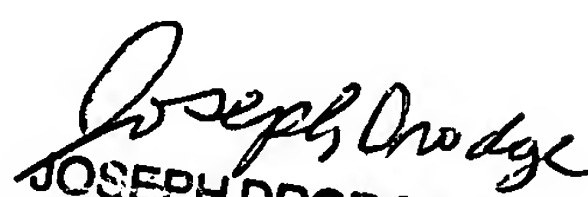
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

February 13, 2006


JOSEPH DRODGE
PRIMARY EXAMINER